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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,306	04/25/2001	Kurt E. Spears	10011001-1	7110

7590 09/26/2003
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ROBINSON, MARK A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,306

Applicant(s)

SPEARS, KURT E.

Examiner

Mark A. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,20,21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/28/03 has been entered.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe 4623937.

Watanabe shows in fig. 5 an image scanner including a lens array(62) between two parallel surfaces (see fig. 10), and a mirror(60) which can be reoriented to various (first and second) positions.

4. Claim 20 is rejected under 35 U.S.C. 102(a) as being anticipated by JP 2001024847.

JP '847 shows an image scanner including a lens array(28) between two parallel surfaces (see fig. 1 or 2), and a mirror(30) which can be reoriented to various (first and second) positions.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Lemelson 4752808.

Watanabe does not disclose a video display. However, video displays are very common and an example of such is shown by Lemelson (note the paragraph bridging columns 10-11 and the first three paragraphs of col. 11 for a teaching of a video display used in conjunction with an image scanner). Use of light emitted from a video display as taught by Lemelson would have been obvious to the ordinarily skilled artisan at the time of invention in concert with the scanner of Watanabe in order to enable the capture of images from such a source.

7. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001024847 in view of Lemelson.

JP '847 does not disclose a video display. However, video displays are very common and an example of such is shown by Lemelson (note the paragraph bridging columns 10-11 and the first three paragraphs of col. 11 for a teaching of a video display used in conjunction with an image scanner). Use of light emitted from a video display as taught by Lemelson would have been obvious to the ordinarily skilled artisan at the time of invention in concert with the scanner of JP '847 in order to enable the capture of images from such a source.

Response to Arguments

8. Applicant's arguments concerning the reorientable mirror have been considered but they are not persuasive.

The examiner's arguments set forth in paper no. 11 are repeated. It should be further noted that it has been held that phrases such as "can be" and "capable of" are not positive limitations and do not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138. Accordingly, since the claims do not specify any particular structure or means for accomplishing reorientation or swiveling of the mirror, the

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prior art meets the language "can be reoriented" and "can be oriented" as found in claims 1 and 20, respectively.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MR

9/23/03


MARK A. ROBINSON
PRIMARY EXAMINER